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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/855, 779 05/12/97 MODI

J MODI-CASE-2

HM12/0803

DAVID EDWARDS  
INTELLECTUAL PROPERTY SECTION  
HERCULES INCORPORATED HERCULES PLAZA  
WILMINGTON DE 19894-0001

EXAMINER

VENKAT, J

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

08/03/99

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/855,779</b>	Applicant(s) <b>MODI</b>
	Examiner <b>JYOTHSNA VENKAT</b>	Group Art Unit <b>1615</b>

Responsive to communication(s) filed on Oct 26, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-44 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Receipt is acknowledged of amendment A , and 132 (b) petition . The petition has been granted .

Claims 42-44 are added as per applicants amendment dated 10/26/98 . Claims 1-44 are pending in the application and the status of the application is as follows :

The following new ground of rejection is necessitated by the amendment .

#### ***Claim Rejections - 35 U.S.C. § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 lacks antecedent basis . The specification does not describe the “ alkyl “ as substituted alkyl . The species claimed in claim 44 does not belong to claim 1 under “ alkyl “ .

The rejection of claims 1-8 , 10 and 44 under 35 U.S.C. 102 (b) over Angerer '733 is maintained for reasons of record .

Applicant's arguments filed 10/26/98 have been fully considered but they are not persuasive.

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Applicants argue that the patent is drawn to latex compositions and the patent does not disclose at least one other personal care ingredient for a personal care composition .

In response to the above argument , it is the examiners position that examples disclose “ ethylene glycol , defoamer , and silica “ which are used in the personal care compositions . The compound is the same . A chemical compound and its properties are inseparable . See In re Spada 15 USPQ 2 nd 1655,1658 .

The rejection of claims 1-8 and 44 under 35 U.S.C. 102 (b) over Sau '772 is maintained for reasons of record .

Applicant's arguments filed 10/26/98 have been fully considered but they are not persuasive.

Applicants argue that the patent discloses a mixed hydrophobic polymer with at least two hydrophobic radicals where one can be 3-alkoxy-2-hydroxypropyl hydroxy ethyl cellulose where the alkyl has 6-24 carbon atoms and the long chain alkyl group is an associative thickener whereas the instant invention is not an associative thickener in view of the short chain alkyl.

In response to the above argument , it is the examiners positions there is overlap of the alkyl chain , and the species claimed belongs to 3-alkoxy-2-hydroxypropyl hydroxy ethyl cellulose . Applicants attention is drawn to all the examples in the specification .

Applicants admit that the patent at col.10 , lines 10-13 discloses its use as thickener in cosmetics and shampoos , but argue that the patent does not enable or teach one skilled in the art on how to practice the invention for cosmetics and shampoos .

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In response to the above argument , it is the position of the examiner that the patent at col.7 , lines 5-15 disclose ingredients which are used in cosmetics and shampoos . TiO<sub>2</sub> is used in cosmetics and surfactants are used in shampoos . See In re Spada to the point .

The rejection of claims 1,8, 9 and 44 under 35 U.S.C. 102 (b) over t'Sas '207 is maintained for reasons of record .

Applicant's arguments filed 10/26/98 have been fully considered but they are not persuasive.

Applicants argue that the reference is drawn to building compositions and does not disclose applicants claimed invention of using the species for personal care compositions .

In response to the above argument , it is the examiners position that applicants are using the same compound in all the examples . The claims are drawn to compositions and the patent at col.4 , lines 15-20 disclose additives which are used in personal care compositions . Plasticizers are used in manicure and pedicure compositions , surface active agents and defoamers are used in hair care art . The 102 rejection is deemed proper . See In re Spada to the point .

The rejection of claims 11-43 under 35 U.S.C. 103 over Angerer or Sau is maintained for reasons of record .

Applicant's arguments filed 10/26/98 have been fully considered but they are not persuasive.

Applicant argues that applicants are using a non associative thickener that has never been used before in personal care compositions . Applicants also argues that there is nothing in the

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Angerer reference or any secondary teaching that would lead him to use the claimed compounds in personal care compositions .

In response it is the position of the examiner that the compound that has been used in the examples of the specification belongs to compound of Angerer when the carbon chain is 6 carbon atoms . The patent discloses various additives that can be used . One of ordinary skill in the art would be motivated to use the compounds of Angerer in personal care products because the compounds are substantially completely soluble in water and they exhibit high shear viscosity .

Applicant argues that the Sau patent disclose in col.10 , lines 10-13 that the polymers can be used in cosmetics and shampoos , but the patent does not enable a person having ordinary skill in the art to use the compounds in cosmetics or shampoos .

In response to the above argument , it is the position of the examiner that the patent discloses the utility in cosmetics and shampoos and the patent discloses various ingredients that can be added to the polymers. There is no example to cosmetics or shampoos , however the reference is valid for the entire disclosure . One of ordinary skill in the art would be motivated to use the same polymers and combine it with the additives disclosed in the patent and use it in personal care products in view of its water solubility .

In conclusion the 103 rejection is deemed proper .

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **J.VENKAT** whose telephone number is **(703) 308-2439**. The examiner can normally be reached on **MON-FRI from 9:30AM to 5:00PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **THURMAN K.PAGE**, can be reached on **(703) 308-2927**. The fax phone number for the organization where this application or proceeding is assigned is **(703) 305-3592**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 308-1235**.

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**J.VENKAT PH.D  
PRIMARY EXAMINER  
ART UNIT 1615**